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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,482	01/02/2002	Irun R. Cohen	COHEN=42A	5950

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EXAMINER

HELMS, LARRY RONALD

ART UNIT PAPER NUMBER

1642

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/032,482	COHEN ET AL.	
	Examiner	Art Unit	
	Larry R. Helms	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3 in part, drawn to a method of inducing an immune response by administration of a DNA molecule encoding the variable region of an anti-p53 mAb, classified in class 514, subclass 44. It is noted that if this group is elected and claims are added or amended that claim the DNA encoding the peptides of the CDRs recited in claims 4-6, a further restriction will be imposed.
 - II. Claims 1-4 in part, drawn to a method of inducing an immune response by administration of a peptide of SEQ ID NO:9, classified in class 514, subclass 2.
 - III. Claims 1-4 in part, drawn to a method of inducing an immune response by administration of a peptide of SEQ ID NO:10, classified in class 514, subclass 2.
 - IV. Claims 1-6 in part, drawn to a method of inducing an immune response by administration of a peptide of SEQ ID NO:11, classified in class 514, subclass 2.
 - V. Claims 1-6 in part, drawn to a method of inducing an immune response by administration of a peptide of SEQ ID NO:12, classified in class 514, subclass 2.

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- VI. Claims 1-4 in part, drawn to a method of inducing an immune response by administration of a peptide of SEQ ID NO:13, classified in class 514, subclass 2.
- VII. Claims 1-4 in part, drawn to a method of inducing an immune response by administration of a peptide of SEQ ID NO:14, classified in class 514, subclass 2.
- VIII. Claims 1-4 in part, drawn to a method of inducing an immune response by administration of a peptide of SEQ ID NO:15, classified in class 514, subclass 2.
- IX. Claims 1-6 in part, drawn to a method of inducing an immune response by administration of a peptide of SEQ ID NO:16, classified in class 514, subclass 2.
- X. Claims 1-6 in part, drawn to a method of inducing an immune response by administration of a peptide of SEQ ID NO:17, classified in class 514, subclass 2.
- XI. Claims 1-4 in part, drawn to a method of inducing an immune response by administration of a peptide of SEQ ID NO:18, classified in class 514, subclass 2.
- XII. Claims 1-4 in part, drawn to a method of inducing an immune response by administration of a peptide of SEQ ID NO:19, classified in class 514, subclass 2.

- XIII. Claims 1-6 in part, drawn to a method of inducing an immune response by administration of a peptide of SEQ ID NO:20, classified in class 514, subclass 2.
- XIV. Claims 1-6 in part, drawn to a method of inducing an immune response by administration of a peptide of SEQ ID NO:21, classified in class 514, subclass 2.
- XV. Claims 1-6 in part, drawn to a method of inducing an immune response by administration of a peptide of SEQ ID NO:22, classified in class 514, subclass 2.
- XVI. Claims 1-6 in part, drawn to a method of inducing an immune response by administration of a peptide of SEQ ID NO:23, classified in class 514, subclass 2.
- XVII. Claims 1-6 in part, drawn to a method of inducing an immune response by administration of a peptide of SEQ ID NO:24, classified in class 514, subclass 2.
- XVIII. Claims 1-6 in part, drawn to a method of inducing an immune response by administration of a peptide of SEQ ID NO:25, classified in class 514, subclass 2.
- XIX. Claims 4 and 7 in part, drawn to a method of inducing an immune response by administration of two different peptides of SEQ ID NO:9-20.
This Group contains multiple groups, i.e, one for each of the combinations of two peptides. If one of these groups are elected then applicant is

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required to pick the two peptides. Applicant is reminded that this is not a species election as each pair of peptides is distinct. classified in class 514, subclass 2.

XX. Claims 8-9 in part, drawn to a peptide of SEQ ID NO:9, classified in class 530, subclass 300.

XXI. Claims 8-9 in part, drawn to a peptide of SEQ ID NO:10, classified in class 530, subclass 300.

XXII. Claims 8-10 in part, drawn to a peptide of SEQ ID NO:11, classified in class 530, subclass 300.

XXIII. Claims 8-10 in part, drawn to a peptide of SEQ ID NO:12, classified in class 530, subclass 300.

XXIV. Claims 8-9 in part, drawn to a peptide of SEQ ID NO:13, classified in class 530, subclass 300.

XXV. Claims 8-9 in part, drawn to a peptide of SEQ ID NO:14, classified in class 530, subclass 300.

XXVI. Claims 8-9 in part, drawn to a peptide of SEQ ID NO:15, classified in class 530, subclass 300.

XXVII. Claims 8-10 in part, drawn to a peptide of SEQ ID NO:16, classified in class 530, subclass 300.

XXVIII. Claims 8-10 in part, drawn to a peptide of SEQ ID NO:17, classified in class 530, subclass 300.

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XXIX. Claims 8-9 in part, drawn to a peptide of SEQ ID NO:18, classified in class 530, subclass 300.

XXX. Claims 8-9 in part, drawn to a peptide of SEQ ID NO:19, classified in class 530, subclass 300.

XXXI. Claims 8-10 in part, drawn to a peptide of SEQ ID NO:20, classified in class 530, subclass 300.

XXXII. Claims 8-11 in part, drawn to a peptide of SEQ ID NO:21, classified in class 530, subclass 300.

XXXIII. Claims 8-11 in part, drawn to a peptide of SEQ ID NO:22, classified in class 530, subclass 300.

XXXIV. Claims 8-11 in part, drawn to a peptide of SEQ ID NO:23, classified in class 530, subclass 300.

XXXV. Claims 8-11 in part, drawn to a peptide of SEQ ID NO:24, classified in class 530, subclass 300.

XXXVI. Claims 8-11 in part, drawn to a peptide of SEQ ID NO:25, classified in class 530, subclass 300.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups XX-XXXVI represent separate and distinct products which have different structures. The proteins of Groups XX-XXXVI are structurally and functionally distinct from each other and would require a separate search in the databases and art on one peptide would not be art on another. The examination of all

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groups would require different searches in the U.S. Patent shoes and the scientific literature and would require the consideration of different patentability issues. Thus the inventions XX-XXXVI are patentably distinct.

The methods of Inventions I and II-XIX differ in the method objectives and parameters and reagents. The invention of Group I require using a DNA molecule that encodes a variable region, while Groups II-XIX do not. In addition the methods of Groups II-XIX differ in that each method uses a distinct peptide or combination of peptides. Thus Inventions I and II-XIX are separate and distinct in having different method objectives and parameters used and different reagents and are patentably distinct.

Inventions IXX-XXXVI and II-XVII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the peptides can be used for detection of antibodies or purification of antibodies in addition to the materially different methods of Group II-XVII.

3. The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance

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with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different classifications, restriction for examination purposes as indicated is proper.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry R. Helms, Ph.D, whose telephone number is (571) 272-0832. The examiner can normally be reached on Monday through Friday from 6:30 am to 4:00 pm, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (571) 272-0871.

7. Papers related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Fax Center telephone number is (703) 308-4242.

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Respectfully,

Larry R. Helms Ph.D.

571-272-0832



LARRY R. HELMS, PH.D
PRIMARY EXAMINER